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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,521	12/10/2001	Martin Schulein	4366.220-US	2575

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EXAMINER

SLOBODYANSKY, ELIZABETH

ART UNIT PAPER NUMBER

1652

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,521

Applicant(s)

SCHULEIN ET AL.

Examiner

Elizabeth Slobodyansky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 February 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 106-131 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 106-131 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 08/651,136.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

The preliminary amendment filed concurrently with the application on December 10, 2001 canceling claims 2-10, 12-65, 67,-83,87,88, 90, 92-96 and 101-105 has been entered.

The preliminary amendment filed on February 21, 2003 canceling claims 1, 11, 66, 84-86, 89, 91 and 97-100 and adding claims 106-131 has been entered.

Claims 106-131 are pending.

Priority

Applicants can not obtain the benefit of the priority date of Danish application 0272/95 filed March 17, 1995 because they have not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows: the specification should be amended to indicate that grandparent application 08/651,136 is a continuation of PCT/DK96/00105 filed March 18, 1996.

Specification

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825. 37 CFR 1.821(d) requires the use of assigned sequence

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identifier in all instances where the description or claims of a patent application discuss sequences.

The following are examples of noncompliance where the sequence containing more than ten nucleotides is given without a sequence identifier: the sequences shown in Figures 1 and 3 are not identified by the sequence identifiers either in the drawings or in the Brief Description of the Drawings.

There is no paper copy of the Sequence listing in the case. The computer readable form has been transferred from the parent case. Applicants are required to provide the paper copy identical to the computer readable form and the statement attesting that the content of the paper and the computer readable copies of the "Sequence Listing" are identical as required by 37 CFR 1.821(f).

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code on page 7, line 8, for example. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

The disclosure is objected to because some abbreviations are not defined such as , for example, "S-CEVU" (e.g., page 57, 66), "DSC" (e.g., page 66). On page 66

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headings for the table are dislocated. On pages 68, 70, etc. there are no headings to the table columns.

Claim Objections

Claim 129 is objected to because "122" was typed instead of "129".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 118-122 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

It is apparent that *Saccharomyces cerevisiae* DSM 10081 is required to practice the claimed invention. As a required element it/they must be known and readily available to the public or obtainable by a repeatable method set forth in the specification. If it/they is/are not so obtainable or available, the enablement

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requirements of 35 U.S.C. § 112, first paragraph, may be satisfied by a deposit of the microorganism(s). See 37 C.F.R. § 1.802.

The specification does not provide a repeatable process for obtaining the microorganism(s) and it is not apparent if the microorganism(s) is/are readily available to the public. The specification must contain the date that the microorganism(s) was/were deposited, the name of the microorganism(s) and the address of where the microorganism(s) was/were deposited.

If the deposit(s) has/have been made under the terms of the Budapest Treaty, then an affidavit or declaration by Applicants or someone associated with the patent owner who is in a position to make such assurances, or a statement by an attorney of record over his/her signature, and registration number, stating that the specific strain(s) has/have been deposited under the Budapest Treaty and that all restrictions imposed by the depositor on the availability to the public of the deposited material will be irrevocably removed upon the granting of a patent, would satisfy the deposit requirements. See 37 C.F.R. § 1.808.

If the deposit(s) has/have not been made under the Budapest Treaty, then in order to certify that the deposit(s) meets the criteria set forth in 37 C.F.R. § 1.801-1.809, Applicant(s) may provide assurance of compliance by an affidavit or declaration, or by a statement by an Attorney of record over his/her signature and registration number, showing that:

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(a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;

(b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;

(c) the deposit(s) will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer;

(d) a viability statement in accordance with the provisions of 37 C.F.R. § 1.807; and

(e) the deposit will be replaced should it become necessary due to inviability, contamination or loss of capability to function in the manner described in the specification.

In addition, the identifying information set forth in 37 C.F.R. § 1.809 (d) should be added to the specification. See 37 C.F.R. § 1.803-1.809 for additional explanation of these requirements.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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Claim 106 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 106 recites "washing in 2 x SSC and 0.5% SDS at a temperature of 60° C, 65° C, 70° C or 75° C". Since different sequences hybridize under different temperatures the metes and bounds of the claim are unascertainable.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 106-129 are rejected under 35 U.S.C. 102(b) as being anticipated by

Skinner et al.

Skinner et al. (US Patent 4,081,328) teach the production of a cellulase by a thermophilic fungus *Thielavia terrestris* (NRRL 8126). They teach that said cellulase exhibits both C₁ and C_x enzyme activity at temperatures from 60° C to about 70° C at pH from about 5.0 to about 5.6 (column 3, lines 54-64; column 6, lines 23-33, claim 1). C_x activity is measured using as a substrate carboxymethylcellulose (CMC) (column 1,

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lines 38-41). This is the same activity as measured by Applicants as S-CEVU (page 57).

Since the amino acid sequence is an inherent property of a protein, the isolated cellulase taught by Skinner et al. appears to be identical to the endoglucanase of the instant invention.

Claims 106-129 are rejected under 35 U.S.C. 102(b) as being anticipated by Yu et al.

Yu et al. (US Patent 4,966,850) teach endoglucanase from *Thielavia terrestris* strain 464 (column 17, line 7; column 18, line 19). Since the amino acid sequence is an inherent property of a protein, absent evidence to the contrary, the isolated endoglucanase taught by Yu et al. anticipates the endoglucanase of the instant invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 130 and 131 are rejected under 35 U.S.C. 103(a) as being unpatentable over Skinner et al. or Yu et al.

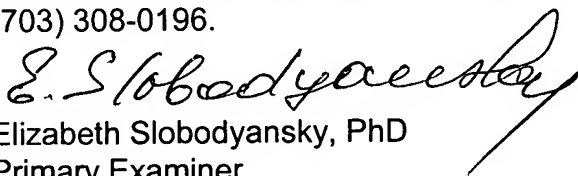
The teachings of Skinner et al. and Yu et al. are outlined above. Each teach the industrial importance of cellulase/endoglucanase and their use.

It would have been obvious to one of ordinary skill in the art the invention was made to prepare a detergent composition comprising the endoglucanase taught by either Skinner et al. or Yu et al. and use in laundry.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.


Elizabeth Slobodyansky, PhD
Primary Examiner

March 7, 2003